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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,282	10/16/2006	Luitpold Miller	3468	1876

7590 02/20/2009

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EXAMINER	
SMITH, JASON C	
ART UNIT	PAPER NUMBER
3617	

MAIL DATE	DELIVERY MODE
02/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/550,282	MILLER ET AL.	
	Examiner	Art Unit	
	Jason C. Smith	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-11 and 14-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-11 and 14-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2005* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *09/22/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 09/22/2005 is being considered by the examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 2, 3, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Powell et al. (5,649,489).** Powell et al. discloses (See figures 1-5, 14, 19, and 23) a guideway with a sliding surface (78) for magnetically levitated vehicles (32) having at least one sliding skid (62) for being set-down onto said sliding surface, wherein said sliding surface is provided with a coating (108, 110) which comprises at least in an outer area a ground or matrix material to which an additional material is admixed, said additional material being tribulogically active material for reducing friction and wear (112) and being compatible with a sliding skid material of said sliding skid. Regarding a ground material to which an additional material is admixed, As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith."

In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). "Even though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966; [claims 2 and 3] see col. 13, lines 36-67, and col. 14, lines 1-3.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. (5,649,489) and in view of Arai et al. (2004/0144960).** Powell et al. discloses the sliding skates set forth above, but does not disclose them composed of carbon fiber enriched with SiC. However, Arai et al. does disclose the carbon fiber-reinforced carbon enriched with SiC. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide the carbon fiber-reinforced carbon enriched with SiC disclosed in Powell in view of the teaching of Arai et al. The motivation for doing so would have been to provide the sliding skate that would be able

to handle the friction energies that are induced when the vehicle is sliding on the surface. Regarding a ground material to which an additional material is admixed, As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). "Even though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966; [claims 16 and 17] see col. 13, lines 36-67, and col. 14, lines 1-3 of Powell.

6. **Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. (5,649,489) in view of Takahashi et al. (2004/0096575).** Powell discloses the guideway carrier set forth above, but does not disclose one layer made up of polyurethane. However, Takahashi et al. does disclose a magnet with a layer of polyurethane (0173). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a layer made up of polyurethane disclosed in Powell in view of the teaching of Takahashi et al. The motivation for doing so would have been to provide the sliding surface with corrosion protection. Powell discloses the claimed invention except for the outer layer comprised of 30 percent by weight to 50 percent by weight of graphite as additional material. It would have been obvious to one

having ordinary skill in the art at the time of the invention was made to use a certain percentage of graphite as the outer layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin,* 125 USPQ 416. The motivation for doing so would have been because the selection of one particular range of percentages of graphite would provide the predictable result of optimizing the properties of the material for a particular application at hand.

7. **Claims 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. (5,649,489) in view of Takahashi et al. (2004/0096575) in view of Thompson et al. (2003/0089581).** Powell discloses the claimed invention except for the outer layer comprised of 10 percent by weight to 40 percent by weight of polytetrafluorethylene as additional material. However, Thompson et al. does disclose an outer layer of polytetrafluorethylene (0057). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a certain percentage of polytetrafluorethylene as the outer layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin,* 125 USPQ 416. The motivation for doing so would have been because the selection of one particular range of percentages of polytetrafluorethylene would provide the predictable result of optimizing the properties of the material for a particular application at hand

8. **Claims 6-7, 9, 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. (5,649,489) in view of Takahashi et al. (2004/0096575) in view of Watanabe et al. (2003/0104246).** Powell discloses the guideway carrier set forth above, but does not disclose one layer made up of epoxy resin. However, Watanabe et al. does disclose a magnet with a layer of epoxy resin (0031). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a layer made up of epoxy resin disclosed in Powell in view of the teaching of Watanabe et al. The motivation for doing so would have been to provide the sliding surface with corrosion protection. Powell discloses the claimed invention except for the outer layer comprised of 10 percent by weight to 30 percent by weight of graphite as additional material. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a certain percentage of graphite as the outer layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin,* 125 USPQ 416. The motivation for doing so would have been because the selection of one particular range of percentages of graphite would provide the predictable result of optimizing the properties of the material for a particular application at hand

9. **Claims 8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. (5,649,489) in view of Takahashi et al. (2004/0096575) in view of Watanabe et al. (2003/0104246) in view of Thompson et al. (2003/0089581).** Powell discloses the claimed invention except for the outer layer comprised of 10 percent by

weight to 40 percent by weight of polytetrafluorethylene as additional material. However, Thompson et al. does disclose an outer layer of polytetrafluorethylene (0057). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a certain percentage of polytetrafluorethylene as the outer layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin,* 125 USPQ 416. The motivation for doing so would have been because the selection of one particular range of percentages of polytetrafluorethylene would provide the predictable result of optimizing the properties of the material for a particular application at hand

10. **Claims 10 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. (5,649,489) in view of Takahashi et al. (2004/0096575) in view of Watanabe et al. (2003/0104246) in view of Tozoni (5,140,208).** Powell discloses the guideway carrier set forth above, but does not disclose a layer made up of steel. However, Tozoni does disclose a steel surface (1). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a steel surface disclosed in Powell in view of the teaching of Tozoni. The motivation for doing so would have been to provide a rigid rail that can support a guideway carrier.

11. **Claims 11 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. (5,649,489).** Powell discloses the claimed invention except for the maximum film thickness of 1 mm. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a maximum 1 mm thickness,

since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin,* 125 USPQ 416. The motivation for doing so would be because the selection of one particular value of maximum thickness would provide the predictable result of optimizing the properties of the material for a particular application at hand.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason C. Smith whose telephone number is (571) 270-5225. The examiner can normally be reached on M- F, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Joseph Morano/
Supervisory Patent Examiner, Art Unit 3617

/Jason C Smith/
Examiner, Art Unit 3617